UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,061	08/20/2004	Pramod Jain		5060

			EXAMINER
36987	7590	08/22/2006	GORTAYO, DANGELINO N

PRAMOD JAIN
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ART UNIT	PAPER NUMBER
2168	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr>
<td rowspan="2">Office Action Summary</td>
<td>Application No.</td>
<td>Applicant(s)</td>
<td></td>
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<tr>
<td>10/711,061</td>
<td>JAIN ET AL.</td>
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<td rowspan="2"></td>
<td>Examiner</td>
<td>Art Unit</td>
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<td>Dangelino N. Gortayo</td>
<td>2168</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 August 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-3</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 August 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>8/20/04</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-3 are pending.

Information Disclosure Statement

2.   An initialed and dated copy of Applicant's IDS form 1449, filed 8/20/2004, is

attached to the instant Office action.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 1 refers to a system, but lacks any

tangible hardware, memory, input/outputs, and sources. This claim can then be

interpreted as software per se, and is non-statutory. Additionally, claim 1 is directed to

neither a "process" nor a "machine", but rather overlaps two different statutory classes

of invention. Claims 2 and 3 refer to a method comprising programs, which is disclosed

as software, with no reference to hardware. Additionally, claims 2 and 3 are directed to

neither a "process" nor a "machine", but rather overlap two different statutory classes of

invention. Proper correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.　　　Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 claims both an apparatus and methods of using the apparatus, wherein the apparatus is the system, and is indefinite under 35 U.S.C. 112, 2nd paragraph. The method steps using the apparatus are ambiguous. Proper correction is required.

　　　Claims 2 and 3 claim both an apparatus and methods of using the apparatus, wherein the apparatus is the programs for the method, and is indefinite under 35 U.S.C. 112, 2nd paragraph. The method for the apparatus is ambiguous. Proper correction is required.

　　　Additionally, Claim 2 recites the limitation "said annotation resources" in line 2. There is insufficient antecedent basis for this limitation in the claim. Proper correction is required.

Claim Rejections - 35 USC § 102

7.　　　The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.   Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by <u>Gertz</u> et

al. ("Annotating Scientific Images: A Concept Based Approach"; Gertz et al. July 2002;

Proceedings 14th International Conference on Scientific and Statistical Database

Management, pages 59-68).

As per claim 1, <u>Gertz</u> teaches "A system for creating annotation resources, for an

image, comprising:" (see Abstract, pg. 1)

"a. A method to identify feature in the said image by drawing, an annotation in a

free form manner in a transparent annotation layer placed on top of the said image, with

an annotation tool that is specific to the type of the identified feature;" (pg. 8, Section 4.

Prototype Application, paragraph 4, wherein a user can mark regions of interest in an

image and assign annotation)

"b. A method to generate a domain object for the identified feature from a domain

class definition that is specific to the said feature type, where the said domain class

definition specifies a list of attributes;" (pg. 8, Section 4. Prototype Application,

paragraph 5)

"c. A method to automatically compute values for some of the said attributes, and

a method for users to enter values for rest of the said attributes;" (pg. 6, Section 3.2

Annotation-level Mechanisms, paragraph 4)

"d. A method to store the annotation geometry of the said feature in the said

domain object;" (pg. 6, Section 3.1 Overview, paragraph 4)

"e. A method to store the said domain objects of the said features in database or file;" (pg. 2, Section 2.1 Requirements and Assumptions, paragraph 3 and Figure 3 "DBMS")

"f. A method to create metadata for the annotation resource" (pg. 7, Section 3.3 Concept-level Mechanisms, paragraph 1)

As per claim 2, <u>Gertz</u> teaches "A method for searching, retrieving and graphically rendering the said annotation resources, comprising:" (see Abstract, pg. 1)

"a. A program to allow user to enter keywords and/or enter attribute names, attribute values and relationships like equal to, less than, greater than, between and others, for the purposes of searching metadata" (pg. 8, Section 4. Prototype Application, paragraph 3)

"b. A program to use the search parameters entered in a) to find metadata records in database that meet the said search criteria for display as a list, to retrieve the annotation resource selected by user from the list, and display the annotation resource with the associated image in background" (pg. 4, Section 2.3 Querying an Annotation Graph, paragraph 4)

."c. A program to display the annotation resource creates a transparent layer and renders annotations in said transparent layers" (pg. 9, Section 4. Prototype Application, paragraph 7)

. "d. A program to display all the attributes of an annotated feature contained in the said annotation resource, when the said annotation is highlighted" (pg. 9, Section 4. Prototype Application, paragraph 7)

As per claim 3, <u>Gertz</u> teaches "A method for tracking features and their attributes, in a sequence of two-dimensional images that are generated by taking an image over a period of time or generated by taking parallel slices of a three-dimensional image, and storing the tracking data in the domain objects of annotation resources, comprising:" (pg. 8, Section 4. Prototype Application, paragraph 1)

"a. A program to overlay multiple transparent annotation layers corresponding to each of the sequence of images" (pg. 8, Section 4. Prototype Application, paragraph 1 lines 4-8)

"b. A program in which user chooses the background image on which the said multiple layers are overlaid" (pg. 8, Section 4. Prototype Application, paragraph 1)

"c. A program in which the differences in attribute values are computed and stored in a user specified annotation resource" (pg. 8, Section 4. Prototype Application, paragraph 4)

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Romano et al. (US Patent 6,269,366 B1)

> Cooke et al. (US Patent 6,574,629 B1)
>
> Cragun et al. (US Publication 2004/0260702 A1)
>
> Shneiderman (US Patent 7,010,751 B2)

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dangelino N. Gortayo whose telephone number is (571)272-7204. The examiner can normally be reached on M-F 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dangelino N. Gortayo   Tim T. Vo
Examiner   SPE

                                              TIM VO
                                     SUPERVISORY PATENT EXAMINER
                                       TECHNOLOGY CENTER 2100